

REMARKS / ARGUMENTS

A. Introduction

The present Amendment is in response to the Examiner's Office Action mailed March 8, 2007. Claims 10, 12 and 13 have been cancelled, and claims 1, 3, 7, 9, 14, 16, 18, 19, 20, 22, 23, 26, 27, 28, 37, 38, 39 have been amended. Claims 1-7 and 9, 11 and 14-39 remain pending in view of the above amendments.

The Applicant expresses appreciation to the Examiner for the withdrawal of the obviousness rejection. The Applicant also acknowledges Examiner's consideration of the IDS filed 9/11/06.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. Reconsideration of the application is respectfully requested. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

B. Claim to Priority

The Office Action appeared to indicate that the related applications listed on page 2 of the specification are ineffectual to provide priority of the present application back to the parent patented application (U.S. Patent no. 5,978,565). The Office Action indicated that Applicant is only claiming benefit to application 09/271,585 and the application and patented application are incorporated by reference. Applicant can only assume, based on the heading of the Examiner's inquiry as "Oath/Declaration," that the claim to priority in the Oath/Declaration was viewed by the Examiner as defective to provide priority to the parent patented application.

After diligently reviewing the MPEP, Applicant directs the Examiner to MPEP 201.11 which recites the requirements for claiming priority to a prior co-pending application under 35 U.S.C. 120:

III. REFERENCE TO PRIOR APPLICATION(S)

The third requirement of the statute is that the later-filed application must contain a specific reference to the prior application. This should appear as the first

sentence(s) of the specification following the title preferably as a separate paragraph (37 CFR 1.78(a)) and/or in an application data sheet (37 CFR 1.76).

A. Reference to Prior Nonprovisional Applications

. . . . [B]enefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number . . . and indicate the relationship between the applications. See 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---."

. . . .

C. Benefit Claims to Multiple Prior Applications

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. [citations omitted] The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

. . . .

D. Reference Must Be Included in the Specification or an Application Data Sheet (ADS)

. . . . If applicant is claiming the benefit of multiple prior applications, the reference to the prior applications may be in a continuous string of multiple sentences at the beginning of the specification. The multiple sentences must begin as the first sentence after the title, and any additional sentence(s) including a

benefit claim must follow the first sentence and not be separated from the first sentence by any other sentence not making a benefit claim

Applicant has diligently reviewed the above MPEP requirements and the specification as originally filed and believes that a proper claim of priority was made in the first paragraph of the specification exactly as required by MPEP 201.11. For the Examiner's convenience, Applicant has reproduced the first paragraph of the specification as originally filed:

This application is a continuation-in-part of U.S. Patent Application Serial No. 09/271,585, entitled "Operation of Standby Server to Preserve Data Stored By a Network Server," filed March 18, 1999, which is a continuation of U.S. Patent Application Serial No. 08/848,139, filed April 28, 1997, entitled "Method for Rapid Recovery from a Network File Server Failure Including Method for Operating Co-Standby Servers," now issued as U.S. Patent No. 5,978,565. The foregoing patent and patent application are incorporated herein by reference.

Applicant respectfully submits that these sentences in the first paragraph of the specification make a proper claim of priority to the parent patented application.

C. Claim Objections

The office action objected to various informalities in claims 3, 7, 14 and 39. As indicated, the following amendments have been made in the claims to overcome these objections:

In claim 3, "using infrastructure of the network" has been changed to "using an infrastructure of the network."

In claim 7, "using the a policing protocol" has been amended to "using the policing protocol." Applicant notes that in Amendment E, the "a" had a strike-through line therethrough, which might have been difficult to identify. As such, double brackets have been used in this listing of the claims to indicate deletion of "a."

In claim 39, "using a the policing protocol" has been amended to "using the policing protocol." Applicant notes that in Amendment E, the "a" had a strike-through line therethrough, which might have been difficult to identify. As such, double brackets have been used in this listing of the claims to indicate deletion of "a."

In claim 14 has been amended to include an "and" after device and before "executing."

Claim 16 has been amended to make lines 8 and 9 of the body to read "mass storage device and while the first server has write access priority to the portion of the first."

D. 35 U.S.C. 112 Rejections

Claims 1, 3, 9, 14, 16, 18-20, 22-23, 26-28 and 38 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Office Action indicated that claims 1, 3, 9, 14, 16, 18-20, 22-23, 26-28 and 38 contain a clause of intended use in the claims which renders the claims indefinite. For example, in claim 1 lines 13-15 the language "thereby mirroring the data at the second mass storage device, wherein the data is stored in a virtual," was considered to recite only what is expected to happen, a desired result, or an intended use. *See* Office Action, page 3. The Office Action indicated that this language is ambiguous as to whether in claim 1 the data is mirrored at the second mass storage device, "wherein the data is stored in a virtual shared storage node from the standpoint of the first server and the second server." *See* Office Action, page 4. The Office Action also indicated that this language failed to interrelate elements. *Id.*

Applicant does not necessarily agree with the Office Actions' rejection of the use of the "thereby" language in the claims. However, in order to advance allowance of the claims, Applicant has amended claims 1, 3, 9, 14, 18, 19, 20, 22, 23, 26, 27, 28, 37 and 38 to remove the "thereby" and "wherein" language objected to by the Examiner. As such, Applicant respectfully requests that the indefiniteness rejection with respect to claim 1, 3, 9, 14, 18, 19, 20, 22, 23, 26, 27, 28, 37 and 38 be withdrawn.

The Office Action indicated that the "thereby enabling" language in claim 16, "enables" in the preamble of claim 20, and "capable of" language in claim 23 were not positive recitations, thus rendering these and other claims having this language indefinite. Applicant does not necessarily agree with this rejection. However, in order to advance allowance of the claims, Applicant has amended claims 16, 20, 23 and 26 to more positively recite the claims and requests that the indefiniteness rejection with respect to claims 16, 20, 23 and 26 be withdrawn.

The Office Action rejected claim 26 as having a conditional statement which the Examiner regarded as rendering the claims indefinite. The Office Action asserted that it was unclear what happens next if the write request does not have priority over any other write request

that is pending for the particular portion of the first mass storage device and the second mass storage device, . . . and if the policing protocol does not determine that the write request does have priority. By this Amendment, Applicant has amended claim 26 to clarify the activity that happens when the write request does have priority and when the write request does not have priority. As such, Applicant respectfully submits that claim 26 is not longer indefinite and requests that the indefiniteness rejection with respect to claim 26 be withdrawn.

Claims 2, 3, 8-15, 17-27, 29, 30 and 35-48 were rejected as depending from a rejected base claim. By this amendment, Applicant has amended the base claims to overcome the indefiniteness rejections and, as such, Applicant respectfully requests that the indefiniteness rejection with respect to claims 2, 3, 8-15, 17-27, 29, 30 and 35-48 be withdrawn.

The Office Action rejected claims 9, 12 and 13 under 35 U.S.C. 112, second paragraph, as being indefinite for particularly pointing out and distinctly claiming the subject matter which applicant regards as the invention. In particular, the Office Action asserted that claim 9 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. Applicant does not necessarily agree with the Examiner.¹ However, in order to advance

¹ Applicant acknowledges the body of recent case law that deals with situations in which claims can be construed to cover both method and apparatus claims, most notably *IPXL Holdings, LLC, V. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005). However, Applicant believes that these situations should be narrowly construed and do not stand for the general proposition that claims having aspects of two statutory classes of invention in all cases are indefinite and/or non-statutory subject matter. Applicant notes that both *IPXL Holdings* and *In re Lyell*, are cited in only one small paragraph of the MPEP 2173.05(p) relating to Product and Process Claims. As such, Applicant does not believe that *IPXL Holdings* or *In re Lyell* stand for the general proposition that if a method claim includes any aspects of a system that such a claim is indefinite.

In *Collaboration Properties, Inc. v. Tandberg Inc.*, 2006 U.S. Dist. LEXIS 42465 (N. D. Cal. June 22, 2006), Collaboration Properties sued Tandberg for infringing claims held by Collaboration. Tandberg asserted that certain method claims were invalid because they recite both the features of a system and a method of using that system. *Id.* at page 2. Tandberg cited *IPXL holdings, LLC, V. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005), arguing that the method claims were indistinguishable from the claims that were invalidated in *IPXL Holdings*. In distinguishing *IPXL Holdings* and holding the method claims at issue valid as definite, the court in *Collaboration Properties* asserted:

Tandberg's argument raises a very basic question about the proper drafting of method claims: can a claimed method be limited to performance on a particular type of apparatus? Both common sense and a cursory inspection of relevant authorities demonstrate that the answer is "yes."

Beginning with common sense, in order to be useful, a patented method must at a minimum be capable of being carried out in the physical world. Methods, ultimately, involve the use of and operate on physical objects. The statutory definition of a "process" is precisely in alignment with this common sense understanding: a process is defined as a "process, art or method, and includes a new use of a known process, *machine*, manufacture, composition of

allowance of the claims, Applicant has amended claim 9 to place the structure limitations referred to by the Examiner into the preamble of the claim so as to clarify the environment in

matter, or material." 35 U.S.C. § 100(b) (emphasis added). Thus a "process," as contemplated under the patent laws, expressly includes the use of a machine.

Indeed, the regime contemplated by Tandberg's argument-method claims divorced from any recitation of a specific apparatus or piece of machinery which can be used to carry out the method-has long been regarded as deeply problematic.

Id. at p. 8-9 (emphasis added). The court in *Collaboration* then discusses *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 14 L. Ed. 601 (1853) and *Cochrane v. Deener*, 94 U.S. (4 Otto) 780, 24 L. Ed. 139, 1877 Dec. Comm'r Pat. 242 (1876), both Supreme Court cases dealing with the relationship of method claims and devices. The court stated:

[T]he salient point in *Cochrane* is that while a process claim may recite a particular device used to perform the process, it need not do so in all cases in order to be valid. *Cochrane* also makes clear that "instrument[s] or machinery" recited in a method claim may properly serve as claim limitations. If a method patent expressly recites the "instrument or machinery" used to carry out the method, then the claim will be limited to the performance of the method using that machinery .

...
....

In light of these cases, which consider the outer limits of what constitutes a patentable process, Tandberg's argument that section 112 precludes method claims from reciting system elements is untenable. There is no ambiguity inherent in claiming a method which involves the use of specific physical objects; indeed, method claims reciting the use of particular devices are the rule rather than the exception. If an inventor claims "The method of driving a nail using a hammer" and the accused infringer drives nails using a rock, there is no doubt that the accused infringer does not literally infringe the claim.

IPXL Holdings says nothing to the contrary. The claim at issue in *IPXL Holdings* was problematic because it purported to be a system claim – one that could be infringed by manufacture or sale, independent of any actual "use" – but contained an element that required user activity. See 35 U.S.C. § 271(a). Tandberg's argument relies on a false assumption about symmetry between system and method claims; while there may be ambiguity in requiring that an action take place in the context of an otherwise inert system claim, as discussed above there is no corresponding ambiguity in requiring that the steps of a claimed method be performed using a particular device. The system limitations merely narrow the method claim's scope.

It is unambiguous from the disputed claim language in this case that one may possess "a plurality of AV devices, each capable of originating and reproducing audio and video signals, a plurality of communications ports each supporting at least one of the group of switch connections consisting of video in, video out, audio in and audio out; and at least one communication path arranged for transport of audio and video signals" without infringing claim 11. In order to infringe claim 11, one must not only possess such a system, but use it in the method recited in the claim.

Id. at p. 11-14 (emphasis added). Also, in *Collaboration Properties*, the accused infringer argued that the format of the method claim by first reciting system elements and then reciting the method bolstered the argument of invalidity. The court similarly held that this did not affect the validity of the claim.

Applicant respectfully submits that method claim 9 is clearly a method claim and does not fall within the narrow case covered by *IPXL Holdings* or *In re Lyell*. However, as indicated above, in order to advance allowance of the claim, Applicant has amended the claim to recite the structure limitations in the preamble of the claim to clarify the environment in which the method operates.

which the method is able to operate. Claims 12 and 13 have also been cancelled. Applicant respectfully submits that, as amended, the indefiniteness rejection with respect to claim 9, 12 and 13 is now rendered moot and requests that the indefiniteness rejection be withdrawn.

E. 35 U.S.C. 101 Subject Matter Eligibility Rejection

The Office Action rejected claim 9, 12 and 13 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Examiner asserts that claim 9 is intended to embrace or overlap two different statutory classes of invention. The Applicant does not necessarily agree.² However, in order to advance allowance of the claims, Applicant has

² The Examiner relied on *Ex Parte Lyell*. Applicant respectfully submits that *Ex Parte Lyell* deals with a very narrow case where the Applicant clearly is attempting to claim *both* an apparatus and a process. In *Ex Parte Lyell*, the disputed independent claim reads as follows:

2. An automatic transmission tool in the form of a workstand and method for using same comprising:
 - a support means,
 - and [sic] internally splined sleeve affixed upright to said support means,
 - a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,
 - and further comprising the steps of
 1. positioning the output end of an automatic transmission onto said upright sleeve,
 2. removing the internal components of said automatic transmission from the casing of said transmission,
 3. repairing and replacing said internal components back into said casing, and
 4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.

The Examiner rejected claim 2 under 35 USC 112, second paragraph, as indefinite.

In traversing the §112 rejection, appellant contends that the apparatus and method involved in the present application are "inextricably related" (brief, page 4) and that the tool is not useful in a practical and patent sense unless the method is disclosed to the user. Appellant urges that we "find that apparatus and method elements of Appellant's claims are sufficiently distinct to enable one skilled in the art of making or using such tools to practice the invention" (emphasis in original), and to further find that "the apparatus and method claims are proper within one patent" (brief, page 5).

Id. at 1550. In affirming invalidity of claim 2 based on indefiniteness, the Board of Patent Appeals and Interferences indicated:

Appellant's independent claim 2, in combining two separate statutory classes of invention in a single claim, in our opinion, would raise serious questions for a manufacturer or seller of a tool like that claimed by appellant regarding infringement. Such a manufacturer or seller would have no indication at the time of making or selling a workstand of the structure set forth in appellant's claim 2 whether they might later be sued for contributory infringement because a buyer/user of the workstand later performs the appellant's claimed method of using the workstand. We therefore find that appellant's claim 2 is not sufficiently precise to provide competitors with an

amended claim 9 to place the structure limitations in the preamble of the claim to clarify the environment in which the method is able to operate. Claims 12 and 13 have also been cancelled. Applicant respectfully submits that, as amended, the rejection based on nonstatutory subject matter is now rendered moot and requests that the 101 rejection to claims 9, 12 and 13 be withdrawn.

F. **Conclusion**

In view of the foregoing, Applicants respectfully submit that claims 1-7 and 9, 11 and 14-39 are in condition for allowance. In the event that the Examiner finds remaining impediments to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

accurate determination of the "metes and bounds" of protection involved so that an evaluation of the possibility of infringement may be ascertained with a reasonable degree of certainty, as discussed by the court in *In re Hammack*, *supra*. Accordingly, for this reason alone we would sustain the examiner's rejection of appellant's independent claim 2 and of dependent claims 4, 7, 8 and 10 through 12 under 35 USC 112, second paragraph.

Id. at 1550-51. In addressing the 35 U.S.C. 101 requirements, the Board stated as follows:

This section of the statute requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). In the situation before us on appeal, it is clear that appellant's independent claim 2 is intended to embrace or overlap two different statutory classes of invention set forth in 35 USC 101. In our view, a claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

Id. at 1551 (emphasis added). The Board indicated that claims must clearly be directed to one statutory class of subject matter. *Id.* at 1551-52. In *Ex Parte Lyell*, the preamble did not clearly set forth a single statutory class, but instead recited both a workstand and a method for using the same. In addition, the Applicant argued that reciting both together in a single claim was necessary.

In contrast, in the present case, claim 9 is clearly directed to a method, as set forth in the preamble. The fact that one of the method steps specifies structural elements of the virtual shared storage node does not rise to the level of reciting two overlapping statutory classes of subject matter. Rather, such specifying the structural elements in method steps is in line with standard patent parlance. However, as indicated above, in order to advance allowance of the claim, Applicant has amended claim 9 to place the structural limitations in the preamble of the claim to clarify the environment in which the method is able to operate.

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Respectfully submitted,

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